

### REMARKS

Favorable reconsideration of the present application as currently constituted is respectfully requested.

Claims 1-43 are pending in the application. Claims 6, 11 and 40-43 have now been cancelled and new claims 44 and 45 have been added.

Page 1 of the specification has been amended to include a reference to the priority document U.S. Provisional Application No. 60/272,433 filed February 28, 2001. Priority to 60/272,433 was claimed under 35 U.S.C. 119(e) in the Combined Declaration and Power of Attorney For Patent Application dated February 26, 2002. The USPTO recognized this priority document in its Filing Receipt (Confirmation No. 7803) wherein said Filing Receipt states "THIS APPLN CLAIMS THE BENEFIT OF 60/272,433 02/28/2001". Further, the present application was published pursuant to 37 CFR 1.211, et seq, having a publication number of US-2002-0117178-A1 and a publication date of 08/29/2002, said publication date being (roughly) 18 months after the filing date of the priority document 60/272,433.

No new matter is introduced.

#### Claims Rejections – 35 U.S.C. § 102

Claims 1-12, 15-19, 22-31 and 40-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Daley (US 5,390,681).

Independent claims 1, 7 and 17 have been amended to more clearly define the invention sought to be protected by them. Claims 40 and 41 have been cancelled.

Applicant submits that Daley does not teach a tongue retention device having a flange sized and shaped to fit in a person's mouth, namely, between a person's lips and teeth or alveolar ridges if teeth are absent. In particular, there is absolutely no suggestion that the prophylactic device for oral sex of Daley is sized to be received between the lips and teeth of a person's mouth. In fact, it is clear that the Daley device is intended to be gripped by a person's hands as illustrated in Figures 4 and 5 and as such would have to be of a size to accommodate a person's hands.

Further, as shown most clearly in Figure 1, the Daley device is not shaped to be received between a person's lips and teeth. In fact, the Daley device comprises a body portion 14 (*i.e.*,

flange) having an oval-shaped rim portion 24 and an oval-shaped bead portion 26. The inner portion of the peripheral rim portion 24 provides a gripping portion for the tips of a person's index finger and thumb of each hand during use (see column 3, lines 5-8). Clearly, the Daley body portion is not of a shape to fit between a person's lips and teeth as the rim and bead portion of the body portion would not allow the Daley device to be received between a person's lips and teeth.

In view of the above, it is clear that Daley does not teach nor even suggest a flange which is sized and shaped to be received between the lips and teeth. In fact, Daley teaches away from such a flange, as it would be impossible to comfortably insert the body portion of Daley, which has an oval-shaped rim portion and an oval-shaped bead portion, between a person's lip's and teeth. Thus, the Daley device is structurally very different than the present device as claimed in amended independent claims 1, 7 and 17. Hence, it is submitted that Daley does not teach a flange that is sized and shaped to be received between a person's lips and frontal surface of a person's teeth or alveolar ridges if teeth are absent. Accordingly, based on the foregoing analysis, Applicant submits that claims 1-12, 15-19 and 22-31 are allowable over the cited prior art.

Claims 13-14, 32-33 and 36-39 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Kulick. Such rejection is traversed for the reasons now following. First, Applicant submits that the Examiner has not satisfied his initial burden of establishing anticipation, as a mere assertion that a particular reference anticipates a claim is not enough (*In re Mullin*, 481 F.2d 1333, 1336, 179 U.S.P.Q. 97, 100 (C.C.P.A. 1973)). Second, Applicant submits that Kulick is not properly cited prior art under 35 U.S.C. 102(e) as the present application has an earlier effective filing date than Kulick. Kulick has an effective filing date of April 2, 2001 whereas the present application has an effective filing date of February 28, 2001, such effective filing date being based on the filing date of priority document U.S. 60/272,433 of February 28, 2001. The Applicant claimed the benefit of U.S. 60/272,433 as indicated in the Filing Receipt received from the USPTO.

In summary, it is submitted that claims 13-14, 32-33 and 36-39 are not anticipated by Kulick and as such are allowable.

Claims 6, 11 and 40-43 have been cancelled.

Claims Rejections – 35 U.S.C. § 103

Claims 20-21 and 42-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daley. Applicant traverses these rejections for the reasons now following.

Claims 20 and 21 are dependent upon amended claim 17. Amended claim 17 teaches a tongue retention device comprising a flange being sized and shaped to be received between a person's lips and frontal surface of said person's teeth. As previously mentioned above, Daley does not teach nor even suggest a flange that is sized and shaped to be received between the lips and teeth. In fact, Daley teaches away from such a flange, as it would be impossible to comfortably insert the body portion, which has an oval-shaped rim portion and an oval-shaped bead portion, of the Daley device between a person's lip's and teeth. Hence, Daley does not disclose in figures 1-6 a tongue device for retaining a tongue, substantially as claimed in claim 17.

Thus, it would not have been obvious to the skilled artisan to make a tongue retention device as claimed in claims 20 and 21 in view of Daley. It is submitted that the Examiner has failed to make a *prima facie* case of obviousness.

Claims 42-43 have been cancelled.

Claims 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kulick. As previously mentioned, Kulick has an effective filing date of April 2, 2001 whereas the present application has an effective filing date of February 28, 2001, such effective filing date being based on the filing date of February 28, 2001 of priority document 60/272,433. Thus, Applicant submits that Kulick is not properly cited prior art under 35 U.S.C. 103(a) as the present application has an earlier effective filing date than Kulick. Hence, it is submitted that the Examiner has failed to make a *prima facie* case of obviousness and as such claims 34-35 should now be allowable.

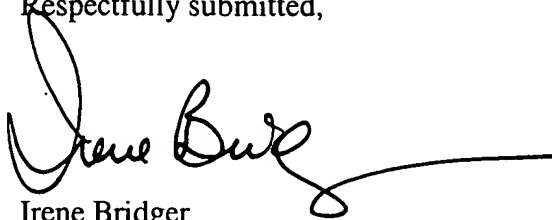
New Claims 44 and 45

New claims 44 and 45 have been added. Support for these claims can be found on page 8, lines 22-27 to page 9, line 1.

**SUMMARY AND CONCLUSION**

In view of the arguments presented by Applicant herein, Applicant submits that claims 1-5, 7-10, 12-39, 44 and 45 are in a condition for allowance and such allowance is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Irene Bridger', with a long horizontal flourish extending to the right.

Irene Bridger  
Registration No. 53,914

Dated: July 14, 2004

Bennett Jones LLP  
4500 Bankers Hall East  
855 2<sup>nd</sup> Street SW  
Calgary, Alberta T2P 4K7  
(403) 298-3661